REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed March 16, 2009.

In the Office Action, the Examiner rejected claims 6-10 under 35 U.S.C. § 101 and claims 1-10 under 35 U.S.C. § 103.

Applicant has amended independent claims 1 and 6 to clarify embodiments of the invention.

Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 101

Claims 6-10 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

The Examiner asserts that independent claim 6 is directed to "computer programs only". Further, the Examiner asserts that the claim limitations related to modules and databases should be interpreted as software *per se*.

Applicant respectfully disagrees with the Examiner. In particular, Applicant respectfully submits that the claims clearly are not computer programs only.

Under MPEP § 2106.01, it is stated that data structures that are descriptive material are not statutory because they are not capable of causing functional changes to the computer. Computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs, are not physical "things". As explained in MPEP § 2106.01: "Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material *per se* and hence not statutory."

Claim 6 is directed to a content delivery system for distributing advertising data to a network of personal computers...comprising: an identification database...an advertisement database...a collection module...a formatting module...and...a control module... The content

delivery system is comprised of plurality of machines or physical structures that perform described functions and is clearly statutory.

Applicant respectfully submits that independent claim 6 is clearly directed to a "machine or physical structure". As set forth in MPEP § 2106.01: "When a computer program is recited in conjunction with a physical structure...USPTO personnel should treat the claim as a product claim." (Emphasis added).

As set forth in MPEP § 2106.IV.B: "For example, a claimed invention may be a combination of devices that appear to be directed to a machine and one or more steps of functions performed by the machine...an apparatus claim with process steps is not classified as a hybrid claim, instead, it is simply an apparatus claim including functional limitations..."

Applicant respectfully submits that the MPEP makes clear that Applicant's content delivery system for distributing advertising data through a network of personal computers including various databases and modules clearly defines a physical structure or machine and is not a "data structure" representing descriptive materials *per se* or a computer program representing computer listings *per se* as indicated by the Examiner.

Therefore, Applicant respectfully submits that independent claim 6 is clearly statutory subject matter under 35 U.S.C. § 101.

Applicant respectfully requests that the Examiner remove this ground for rejection.

Rejection Under 35 U.S.C. § 103

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious over U.S. Patent No. 5,948,061 issued to Merriman et al. (hereinafter Merriman) in view of U.S. Patent No. 6,373,498 issued to Abgrall (hereinafter Abgrall).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine the references. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicant has amended independent claims 1 and 6 such that they generally recite (utilizing independent claim 6 as an example) claim limitations directed to:...a content delivery system for distributing advertising data to a network of personal computers...comprising...an identification database comprising identification data...an advertisement database comprising advertising data, *wherein the advertising data is formatted for storage and display in the network of personal computers while or before the network of personal computers bootload a selected application environment*...and...a control module to: *receive preference data from the personal computers...select the advertisement content that is to be distributed to the network of personal computers based upon at least one of received preference data from the personal computers and pre-determined conditions related to advertisement distribution*...and...distribute the formatted advertisement data to the network of personal computers.

As recognized by the Examiner, on page 5 of the Office Action, Merriman does not disclose the following limitations: "wherein the personal computers are configured to periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment."

The Examiner asserts that Abgrall teaches these limitations. Applicant respectfully disagrees with the Examiner and believes that the Examiner has misconstrued the teachings of Abgrall. Abgrall does not teach or suggest these limitations. Further, Applicant has amended independent claims 1 and 6 to further clarify these claims over the Merriman and Abgrall references. Moreover, Applicant respectfully submits that neither Merriman nor Abgrall teach or suggest:...receiving *preference data* from personal computers and *selecting advertisement content* that is to be distributed to the personal computers based upon at least one of *received preference data* from the personal computers and *pre-determined conditions related to advertisement distribution.*

In contrast to Applicant's claims, Abgrall is directed to an: "invention that relates to graphics...In particular, the invention relates to graphics display." (Abgrall, col. 1, lines 7-8,

emphasis added). Even more particularly, Abgrall is directed to: "a method and apparatus to display an image during a transition of an operating system in a computer system. An image having an image format compatible with the operating system is obtained. Content of a system file corresponding to the transition of the operating system is created using the image in a system directory." (Abgrall, Summary, col. 1, lines 30-35, emphasis added).

In particular, the Examiner relies upon column 4 of Abgrall as being allegedly related to Applicant's claims, which states:

> Once copied, the payload executes after POST but prior to operation of the OS, and may display graphics, advertisements, animation, Joint Photographic Experts Group (JPEG)/Moving Picture Experts Group (MPEG) formatted material on the screen. When additional programs and/or payloads are delivered (via the Internet or other outside connection), the display screen may be used to provide customized screens in the form of messages or graphics prior to and during booting of the OS. In addition, executable programs delivered in the first software module, as well as subsequent programs (such as the second software module) downloaded from the web site, may be used to survey the PC to determine various types of devices, drivers, and applications installed. (Column 4, lines 5-18).

Thus, this section of Abgrall only briefly mentions the term advertisement when it states that once the initial payload is executed that an advertisement may be displayed.

Generally, Abgrall describes that after a program is downloaded from the Internet, that a display screen may be used to provide customized screens in the form of messages and graphics prior to and during booting of the OS. (Abgrall, column 4, lines 9-13).

There is no particular teaching or suggestion in Abgrall of personal computers that periodically receive and store advertising content and display the advertising content while or before bootloading a user selected application environment.

Moreover, Abgrall does not teach or suggest *a control module* to: *receive preference data from personal computers* and *select advertisement content* that is to be distributed to the network of personal computers *based upon at least one of received preference data* from the personal

computers and *pre-determined conditions related to advertisement distribution.* Furthermore, Merriman does not teach or suggest these limitations.

It should be noted that Applicant describes in the patent application's specification various types of preference information such as movies, music, sports, games, news, television, etc. and pre-determined conditions such as various time intervals related to the personal computer, various time thresholds of the distribution server, and new advertisement data being received by the distribution server.

Merriman and Abgrall do not teach or suggest these limitations. In fact, nowhere does either Merriman or Abgrall teach or suggest preference data for selecting advertisement content based upon received preference data from personal computers or pre-determined conditions related to advertisement distribution.

Although, in the Office Action, the Examiner cited column 3, lines 44-52 of Merriman (reproduced below) as being allegedly relevant to received preferences:

> Included in each message 23 typically to the advertising server 19 are: (i) the user's IP address, (ii) a cookie if the browser 16 is cookie enabled and stores cookie information, (iii) a substring key indicating the page in which the advertisement to be provided from the server is to be embedded, and (iv) MIME header information indicating the browser type and version, the operating system of the computer on which the browser is operating and the proxy server type. (Column 3, lines 44-52).

Applicant respectfully submits that a user's IP address, cookie, substring key, or an MIME header are not in any way relevant to a control module selecting advertisement content that is to be distributed to personal computers based upon at least one of received preference data from the personal computers and pre-determined conditions related to advertisement distribution.

Applicant respectfully submits that the claim limitations of amended independent claims 1 and 6 are nowhere taught or suggested by Merriman or Abgrall.

Therefore, as set forth in detail above, Applicant respectfully submits that Merriman and Abgrall, either alone or in combination, do not teach or suggest the limitations of Applicant's amended independent claims 1 and 6.

Thus, Applicant respectfully submits that amended independent claims 1 and 6, and the claims that depend therefrom, are distinguishable over the prior art references, and Applicant respectfully requests that these claims be allowed and passed to issuance.

Conclusion

In view of the remarks made above, it is respectfully submitted that pending claims 1-3, 5-8, and 10 are allowable over the prior art of record. Thus, Applicant respectfully submits that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 6/16/2009

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Attachments

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